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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,002	06/21/2001	David Adams	500582.20033	5044

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EXAMINER

UBILES, MARIE C

ART UNIT	PAPER NUMBER
2642	

DATE MAILED: 12/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/885,002

Applicant(s)

ADAMS ET AL.

Examiner

Marie C. Ubiles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/24/03, 7/20/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not identify the city and either state or foreign country of residence of each inventor. The residence information may be provided on either on an application data sheet or supplemental oath or declaration.

The post office address is missing.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 8-10 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 20 of U.S. Patent No. 6,230,006. Although the conflicting claims are not identical, they are not patentably distinct from each other because they both disclose a system for remotely testing a

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telecommunications network or a switch in a calling area by means of establishing a test call or phone call through a controller and a remote call processor.

In reference to the limitations regarding to the classification of audio signals related to test telephone call and the test telephone call passing or failing, the Examiner takes Official Notice that it is well-known in the art to classify audio signals as busy, fast busy, voice, fax by means, for example, of Mechanized Loop Testing (MLT) of a telephone number.

4. Claims 1-5 and 11-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 14 and 20 of U.S. Patent No. 6,230,006 in view of Dean (US 6201802).

As for claims 1 and 11-15, US 6,230,006 discloses the same system as that claimed by Applicant, with the added limitation "...and for re-synchronizing said remote call processor (RCP) with a time protocol server; accessing said time protocol server so as to re-synchronize said remote call processor".

Dean teaches a system and method to synchronize with the transmission from a base station, a remote unit performs repeated time offset searches with the pilot PN code until the pilot channel is detected. It would have been obvious to one of ordinary skill in the art to add the function taught by Dean to US 6,230,006 and thus in this manner provide proper communication since remaining synchronized with each base station when a telephone call or other communication is in progress is especially useful as it assists in conducting a soft handoff rapidly. (See Background, Col. 1, lines 54-56 and Col. 2, lines 9-14).

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As for claims 2-5, the "time stamping" and "time duration" determination functions may be read on Dean's teachings about how to correct "drifting errors" in a cellular system, measurement of time in the base station is used for such purposes (See, for example, Col. 4, lines 21-33).

5. Claim 6-7 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 20 of U.S. Patent No. 6,230,006 in view of Dean (US 6201802), as applied to claims 1-5 and 11-15 above, and further in view of Vimpari et al. (US 6,169,883).

The combination of US 6,230,006 and Dean taught the system as that claimed by Applicant except for the "...at least one test short message service (SMS) data to said destination telecommunication device; and testing by said controller of said destination telecommunications device receiving said test SMS data so as to verify proper operation of SMS signal transmission in said telecommunications network."

Vimpari et al. teaches the use of SMS or a protocol built on SMS for sending the message starting measurement functions in a cellular system (See Col. 11, lines 13-17). It would have been obvious to one of ordinary skill in the art to modify the combination of US 6,230,006 and Dean, and thus in this manner being able to start a test by means of a remote operation center, a subscriber network element or a base station (See Col. 5, lines 36-46).


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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marie C. Ubiles whose telephone number is (703) 305-0684. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad Matar can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marie C. Ubiles
December 11, 2004.


AHMAD F. MATAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2700